



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

JUL 08 2003

OFFICE OF PETITIONS

RECEIVED

JUL 10 2003

TECHNOLOGY CENTER 2800

Inventor: Krol et al.

Serial No: 10/061,766

Filing Date: 10/26/01

Title: MODULAR OPTICAL SWITCH
FABRIC

Group Art Unit: 2874

Examiner: Valencia, Daniel E.

RESPONSE

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail addressed to the Commissioner for Patents, Alexandria, VA 22313-1450 on July 3, 2003

Lynn L. Pond
Lynn L. Pond

Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

1. Response to Restriction Requirement

In response to the Restriction Requirement dated May 15, 2003, designated as Paper No. 8 in the above-captioned application, the Applicant hereby elects Group I with traverse. Group I includes claims 1 – 53, which are drawn to an modular optical switch fabric and method, classified in class 385, subclass 16.

2. Remarks and Arguments

According to MPEP §803, a restriction is only proper when the Examiner can show that the Groups are independent and distinct, and that the examination of the entire claim set imposes a serious burden on the Examiner. The Applicants will show that Group I and Group II are neither independent nor distinct.

The Applicants first note that Group I is directed to an apparatus and methods for using the apparatus. Group II is directed to a method for maintaining the apparatus. The test for independence is provided by MPEP §806.04. "Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent." (Emphasis added). When the apparatus must be used to practice the method (process), the inventions are dependent. The Applicants have reproduced claim 1 and claim 54 for the Examiner's convenience.

In this case, claim 1 is directed to:

1. A modular optical switch fabric comprising:
an optical chassis; and
at least one optical module removably coupled to the optical chassis, the at least one optical module including a collimator panel and a beam steering panel
secured to a frame member, the frame member being configured to position
the collimator panel in fixed optical alignment relative to the beam steering
panel.

Claim 54 is directed to:

54. A method for maintaining an optical switch fabric being used to direct signal traffic, the signal traffic including light signals being directed from input fibers to output fibers, the method comprising:
providing an optical chassis having a plurality of plug-in slots, the plug-in slots including at least one repair slot;
inserting a plurality of first optical modules into the plug-in slots of the optical chassis, the at least one repair slot being unused, each optical module
including a collimator element and a beam steering element each secured to
a frame member, the frame member being configured to position the
collimator element in fixed optical alignment relative to the beam steering
element;
detecting a maintenance condition; and
inserting at least one second optical module into the at least one repair slot in response to the maintenance condition, whereby the signal traffic is not interrupted.

The Applicants direct the Examiner's attention to the underlined portions of each claim. After comparing these portions it is readily seen that the process of claim 54 cannot be used without the apparatus of claim 1. The apparatus of claim 1 recites an "optical chassis." The first step of method claim 54 is "providing an optical chassis." The apparatus of claim 1 then recites "at least one optical module removably coupled to the chassis." The next step of method claim 54 is "inserting a plurality of first optical modules into...the optical chassis." The optical module recited in claim 1 is identical to each of the optical modules recited in claim 54 because each claim recites "each optical module including a collimator element and a beam steering element each secured to a frame member, the frame member being configured to position the collimator element in fixed optical alignment relative to the beam steering element." It is manifest that the claimed apparatus (Group I) must be used to practice the process (method). Thus, the inventions are dependent, and the restriction is improper.

The test for distinctness is provided by MPEP §806.05(e). A process and apparatus can be shown to be distinct if the claimed process can be practiced by another materially different apparatus. Referring again to the underlined portions of claim 1 and claim 54, the claimed process cannot be practiced by another materially different apparatus. Claim 54 requires both the optical chassis and the optical module recited by claim 1. Thus, Group I and Group II are not distinct inventions.

For the foregoing reasons, the Applicants respectfully request that the Examiner's Restriction Requirement be withdrawn.

3. Conclusion

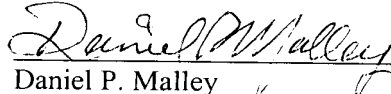
Applicants believe the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 58 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-0289.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

Respectfully submitted,

WALL MARJMA & BILINSKI



Daniel P. Malley

Registration No. 43,443

WALL MARJMA & BILINSKI

101 S. Salina Street

Suite 400

Syracuse, NY 13202

Date: 7/3/03